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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

H25193 US

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on October 10, 2006

Signature

Tracey M. Dotter

Typed or printed name

Tracey M. Dotter

Application Number

091802,254

Filed

3/8/2001

First Named Inventor

Nichols

Art Unit

2616

Examiner

Mills, D.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number

51,419☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

William B. Ashley

Typed or printed name

952-854-2700

Telephone number

10/10/2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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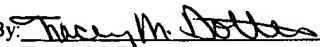
SERIAL NO. 09/802,254

PATENT APPLICATION

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant:	NICHOLS	Examiner:	Mills, D.
Serial No.:	09/802,254	Group Art Unit:	2616
Filed:	March 8, 2001	Docket No.:	H25193 US (HONY.033PA)
Title:	SIMULTANEOUS SERIAL TRANSMISSION OF MESSAGES WITH DATA FIELD ARBITRATION		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 10, 2006.

By: 
Tracey M. Dotter

**APPELLANT'S STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This statement is presented by Appellant in compliance with the USPTO OG Notices on New Pre-Appeal Brief Conference Pilot Program. Appellant is requesting a pre-appeal brief conference on the belief that the rejections of record are clearly not proper and are without basis. Appellant's request is based upon a clear legal or factual deficiency in the rejections, rather than an interpretation of the claims or the prior art teachings. As such, Appellant believes this request for pre-appeal brief review is appropriate.

As noted in the USPTO OG Notice of July 12, 2005, it is encouraged that Appellants refer to arguments already of record rather than repeating them in the request. Thus, the Appellants also refer hereinbelow to the Office Action Responses dated January 2006 and July 2006, which were filed in response to the respective Office Actions dated September 2005 and April 2006. In particular, the Appellants direct the Panel's attention to pages 9-12 of the January 2006 Office Action Response, and pages 8-9 of the July 2006 Office Action Response.

Claims 1-17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter, and under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner has indicated that

Claims 1-17 are otherwise allowable (Office Action, April 2006, page 3, paragraph 5). While the Appellant may have additional issues for *appeal*, the primary purpose for submitting this particular *request for review* concerns omissions of essential elements needed for a *prima facie* rejection.

As to the rejection under 35 U.S.C. §112, second paragraph, the Examiner states that “the content of the *node data value* is unclear from the context of the claim.” (Office Action, April 2006, page 3, paragraph 4, emphasis in original). Appellant first notes that the term “node data value” is clear on its face and in the context of the claims, and one of ordinary skill in the art would not find the term ambiguous or unclear. Second, Appellant has already provided an explanation, that “the node data value is any data associated with each of the first and second nodes.” (Office Action Response, January 2006, page 12, last paragraph). Finally, Appellant notes the guidelines for clarity and precision set forth in MPEP § 2173.02:

When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. (emphasis in original)

Appellant submits that, based on this standard, it is clear error to reject Claims 1-17 under 35 U.S.C. §112, second paragraph based on the use of the term “node data value” because this term defines the patentable subject matter with more than a reasonable degree of particularity and distinctness.

Regarding the rejection under 35 U.S.C. §112, first paragraph, the Examiner stated that Claims 1 and 10 specified “providing the send signal to the message sending module,” and that the “specification describes sending the report messages in a RMG according to a protocol designed to assure that all of them will be sent ...in perfect synchronization.” (Office Action, September 2005, page 2, paragraph 3). Therefore, the Examiner concludes that “[i]f the report messages are transmitted at the same time with the same number of bytes, it is unclear how one would resolve ownership of the bus to complete transmission.” (*Id.*). Appellants traversed, but in the interest of advancing prosecution, explained in detail how this was accomplished and fully supported the Specification as filed. (Office Action Response, January 2006, pages 9-12). However, the Examiner maintained the rejection, repeating that “it is unclear how one would resolve ownership of the bus to complete transmission.” (Office Action, April 2006, page 2, paragraph 2) In response to Appellant’s arguments, the Examiner states that “Applicant explains the (sic) how the resolving of

bus ownership is accomplished...but does not address the issued (sic) raised by the Examiner, in which report messages are transmitted at the same time with an identical number of bytes.” (*Id.*)

Appellant submits there are at least two sources of clear error in this rejection. First, according to MPEP § 2164.01, the test for enablement is “whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.” However, Examiner does state what, if any, claim language is supposedly not enabled by the Specification. The Appellant has not claimed “report messages [that] are transmitted at the same time with the same number of bytes,” yet this is the language used in the rejection as supposedly being unsupported. As a result, the Examiner has not established a *prima facie* case for lack of enablement because the Examiner has not identified **any claim language** that is not enabled.

The second source of clear error lies in the contention that “it is unclear how one would resolve ownership of the bus to complete transmission.” The Appellant’s invention deals with systems that utilize bitwise arbitration, and it is well understood in the art how nodes resolve ownership of the bus using bitwise arbitration, including situations where the “messages are transmitted at the same time with the same number of bytes.” In the Office Action of April 2006, the Examiner admits that “Applicant explains the (sic) how the resolving of bus ownership is accomplished,” and the concept of bitwise arbitration is integral to that explanation. Thus, Appellants submit that the explanation of “how the resolving of bus ownership is accomplished” from the January 2006 Office Action Response is also sufficient to explain “how one would resolve ownership of the bus to complete transmission” if “the report messages are transmitted at the same time with the same number of bytes.”

During a telephone interview between the Examiner and Appellants’ representative on July 6, 2006, the Examiner did not contest that bitwise arbitration handles cases where messages are transmitted at the same time and with the same number of bytes. Instead, the Examiner suggested that the independent claims did not clearly set forth that bitwise arbitration was occurring for each bit of the message. Appellant submits that the rejection under the enablement requirement of 35 U.S.C. §112, first paragraph, is therefore improper, because even if these issues raised by the Examiner were true, they are irrelevant when considering whether or not undue experimentation is needed to practice the claimed invention, which is the test for enablement. MPEP § 2164.01. Further, as to the Examiner’s particular objection raised in the phone interview that the claims do not set forth bit-wise arbitration for each bit of the message, Appellant provided arguments that

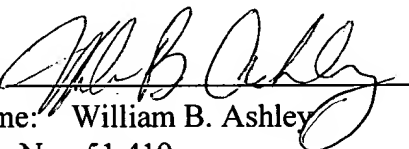
refute the Examiner's contention. (Office Action Response, July 2006, page 8, last paragraph, to page 9). The claim language is non-ambiguous and clearly shows bitwise arbitration occurring for each bit of the message.

In conclusion, Appellant submits that the rejections of Claims 1-17 under 35 U.S.C. § 122, first and second paragraph are clearly erroneous. Further, because the Examiner has not provided any other basis for rejecting these claims, the Appellant respectfully submits that the Application is in condition for allowance.

The undersigned is of record and with authority to prosecute the appeal on behalf of the Assignee.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
Attorneys at Law
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700 (tel.)

By: 
Name: William B. Ashley
Reg. No.: 51,419